

REMARKS

In the Office Action dated March 18, 2003, the Examiner rejected Claims 1 through 27 under 35 U.S.C. §103(a) as being unpatentable over Rivette et al. (U.S. Patent 5,991,751). Applicants respectfully traverse the rejection and request reconsideration.

Claims 6-7, 15-16, and 24-25:

By way of this Response, Applicants have canceled claims 6-7, 15-16, and 24-25. Applicants therefore submit that the rejection as to those claims is now moot.

Claims 1-6, 9-14, 17-23 and 26-27:

The Examiner rejected independent claims 1, 10, and 19 as being unpatentable over Rivette. Because the remaining dependent claims all depend from these three independent claims, allowance of claims 1, 10, and 19 will result in the allowance of all pending claims.

The Applicants' invention relates generally to a system for identifying assignees that are potential licensees of patents that are associated with a particular set of patents (i.e., patents in a source patent portfolio) that are of interest to a user. The patents in the source patent portfolio may be, for example, all of the patents owned by an assignee (who may in turn be the user). The patents in the source patent portfolio will undoubtedly cite as references numerous documents, such as other patents, technical articles, etc. The associated patents may include a set of patents that cite as a reference any patent in the source patent portfolio, or they may be a set of patents that are themselves cited as references by patents in the source patent portfolio. Thus, the associated patents may have issued before or after the patents in the source patent portfolio.

It is from the set of associated patents that assignees that are not currently licensees are listed and ranked, as claimed. Ranking unlicensed assignees allows users to readily determine which assignees of associated patents are potential licensees of the patents in the source patent portfolio. Ranking the assignees according to some specific criteria can give a user of the system insight into assignees with a concentration in the same technical area of the patents in the source patent portfolio, although other uses are possible.

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation to modify a reference or combine the disclosures of multiple references, and the suggestion to make the claimed combination or modification must be found in the cited references, not in the Applicant's disclosure. In addition, the cited reference or combined references must teach or suggest all the claim limitations. (M.P.E.P. § 2143). Rivette, however, fails to show or suggest at least the step of organizing assignees according to a ranking criteria that causes a higher ranking to be given to any assignee when the following ratio is greater for that assignee than for other assignees:

assignee's patents in the set of associated patents : all patents held by assignee.

as required by claims 1, 10, and 19.

Rivette neither shows nor suggests such an organization according to a ranking criteria of remaining assignees. Rivette does not even establish a basic element that would be required to rank the assignees as claimed, namely, the total patents held by each assignee and so that a ratio to the number of patents each assignee has in a set of associated patents can be taken.

Instead, Rivette suggests only that *some* significance may be attached to the number of patents a particular assignee has in a technological field (not patents the assignee has in the precisely defined set of associated patents required in Applicants' invention), or to how recently an

assignee's patents were filed or issued. Rivette, col. 102, lines 44-45 and 58-60. This is done by manual operator review of a so-called "patent citation report."

Thus, Rivette does not show or suggest organizing assignees according to the ranking criteria as defined and claimed by Applicants, and Rivette shows no ranking or organization of an assignee (or assignees) as compared to other assignees, as claimed by Applicants. Because of this, a user of Rivette's system could not easily evaluate potential licensees of a source patent portfolio, especially in a "crowded field," where it would be possible to have hundreds of assignees about which a user must make a subjective determination. According to the specification of Rivette, the patents displayed in Figure 62 "are displayed by patent number," which gives a user no insight into the relative importance of a source patent to an assignee. Indeed, the most important potential licensee could be displayed at the bottom of the list in Figure 62.

In response to Applicants' previous transmittal, the Examiner suggests that ranking assignees by ratio is obvious because "ratio represented as number is one of mathematical manipulation with using different input attributes for numerator and denominator. Thus, ratio of total number of patents held by an assignee to the number of patents held by that assignees in the set of associated patents, are considered merely as mathematical manipulation." The Applicants do not deny that the Examiner has here expressed the proper formula for calculating a ratio. However, the Examiner has pointed to nothing in Rivette that explicitly shows expressing as a ratio patents an assignee has within a specific group to all that assignee's patents, nor has the Examiner shown any motivation within Rivette for calculating the claimed ratio and using it as a ranking criteria. Accordingly, the rejection fails to make out a *prima facie* case of obviousness.

The Examiner's statement that a ratio is "merely [] mathematical manipulation" seems to suggest that the Examiner does not believe Applicants' invention is directed to patentable subject

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matter, although such a rejection has not been properly made. Applicants respectfully point out that the mere fact that a claim contains a well-understood formula does not make the claim unpatentable. More particularly, the existence of a mathematical formula cannot render a claim obvious where use of the formula is not shown by the reference and the Examiner has shown no motivation contained within the reference to use the formula in a novel way, as Applicants have.

Conclusion

Because Rivette's system does not show or suggest organizing assignees according to a ranking criteria, and if it did, it would organize a different group of assignees than Applicant's invention, Rivette fails to anticipate claims 1, 10, and 19. Claims 1, 10, and 19 are therefore allowable, and notice to that effect is requested. Because pending claims 2-5, 8-9, 11-14, 17-18, 20-23 and 26-27 depend ultimately from claims 1, 10, and 19, allowance of those claims will follow directly from the allowance of claims 1, 10, and 19.

Applicants submit that the present application is now in condition for allowance, and notice to that effect is hereby requested. Should the Examiner feel that further dialog would advance the subject application to issuance, he is invited to telephone the undersigned at any time at (312) 935-2373.

Respectfully submitted,

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